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DOCKET NO.: 4000-059-30

ASSISTANT COMMISSIONER FOR PATENTS
BOX PCT
WASHINGTON, D.C. 20231

In Re Application Of: DEBRA L. HICKS, ET AL.
International Application No: PCT/US97/13321
U.S. Serial No.: 09/230,275
International Filing Date: 23 JULY 1997
For: CHOLESTEROL SEPARATION AND FLUORESCENT ANALYSIS

ATTENTION: PCT Legal Office
Mr. Rafael Bacares

SIR:

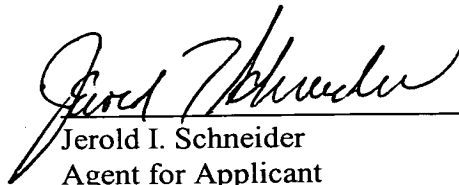
Attached hereto for filing are the following papers:

RENEWED PETITION UNDER 37 CFR 1.137(b) TO REVIVE
UNINTENTIONALLY ABANDONED APPLICATION
NOTIFICATION OF MISSING REQUIREMENTS
DECLARATION (5 pages/executed copy)

Our check in the amount of \$ -0- is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, please charge or credit the difference to our Deposit Account No. 50-1442. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

PIPER MARBURY RUDNICK & WOLFE LLP



Jerold I. Schneider
Agent for Applicant
Registration No.: 24,765

Laura D. Nammo
Registration No.: 42,024

Docket No. 4000-059-30

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: DEBRA L. HICKS ET AL.

U.S. SERIAL NO: 09/230,275

IA FILING DATE: 23 JULY 1997

INTERNATIONAL APP. NO: PCT/US97/13321

PRIORITY DATE: 24 JULY 1996

FOR: CHOLESTEROL SEPARATION AND FLUORESCENT ANALYSIS

**RENEWED PETITION UNDER 37 CFR 1.137(b) TO
REVIVE UNINTENTIONALLY ABANDONED APPLICATION**

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ATTENTION: PCT Legal Office
Mr. Rafael Bacares

SIR:

Pursuant to a telephone discussion on January 8, 2002 with Mr. Rafael Bacares, Applicants hereby submit this Renewed Petition Under 37 CFR 1.137(b) to revive the above-referenced application. A Decision on Petition was mailed September 18, 2001. As discussed below, Applicants respectfully submit that no extension of time and no fee are required. Based on the following, reconsideration on the merits is requested.

FACTS

On July 23, 1997, this international application was filed. Applicants timely filed a Demand electing the United States on February 18, 1998. Accordingly, the deadline for paying

the basic national fee in the United States under 35 U.S.C. § 371 and 37 CFR 1.495 was January 24, 1999. On January 22, 1999, Applicants timely filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. § 371, accompanied by the basic national fee.

On June 2, 1999, a Change of Attorney Address in Application was filed, which indicated that all correspondence for the above-referenced application should be sent to Applicants' counsel at Dorsey & Whitney LLP, 1001 Pennsylvania Avenue NW, Suite 300 South, Washington, DC 20004. The previous correspondence address had been Dorsey & Whitney LLP, 1330 Connecticut Avenue NW, Suite 200, Washington, DC 20026.

On July 7, 1999, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. § 371 indicating that the oath or declaration complying with 37 CFR 1.497(a) and (b) must be furnished within the time period set forth. The notification set a response period of one month from the date of the notification or 31 months from the priority date for the application, whichever was later. The Notification of Missing Requirements mailed July 7, 1999 was never received by Applicants' counsel until January 2002. The address to which the notification was actually sent was Dorsey & Whitney LLP, 1001 Connecticut Avenue NW, Suite 300 South, Washington, DC 20004. This is a non-existing address. Furthermore, the address to which the notification was sent does not correspond to any address ever on file in this application.

On November 2, 1999, Applicants' counsel filed a Change of Attorney Address in Application indicating that all correspondence for the above-referenced application should be sent to Applicants' counsel at Arter & Hadden LLP, 1801 K Street NW, Suite 400K, Washington, DC 20006-1301.

The United States Designated/Elected Office mailed a Notification of Abandonment on March 2, 2000. The notification indicated that Applicant had failed to respond to the Notification of Missing Requirements mailed on July 7, 1999 within the time period set therein. The Notification of Abandonment was also sent to an address that did not correspond to any address ever on file in this application.

On March 30, 2000, Petitioner submitted a Petition to Withdraw Notification of Abandonment requesting that the USPTO withdraw the holding of abandonment because the Notification of Missing Requirements mailed July 7, 1999 was never received.

The petition was dismissed in a decision on May 22, 2000, which was mailed to Applicants' counsel at the correct address of record (*i.e.*, the Arter & Hadden address). The decision stated that the petition did not satisfy item (3) of MPEP § 711.03(c) because that section required counsel to provide a copy of the docket record(s) where the non-received Office communication would have been entered had it been received and docketed. Accordingly, the application remained abandoned.

On June 12, 2000, Petitioner submitted a Renewed Petition Under 37 CFR 1.181 To Withdraw Notification of Abandonment.

In a decision on June 13, 2001 (one year later), the renewed petition was dismissed. The decision stated that the petition had not met the requirements under MPEP § 711.03(c) to establish non-receipt of an Office Action and that withdrawal of the abandonment of the application at such time would not be appropriate. This decision was mailed to the correct address of record.

On July 14, 2001, Petitioner filed a Petition to Revive Unintentionally Abandoned Application, including the required petition fee and the proper statement under 37 CFR 1.137(b). Petitioner noted that the proper "reply" could not be submitted because the Notification of Missing Requirements was never received.

The petition to revive was dismissed in a decision on September 18, 2001. The decision stated that the petition did not satisfy item (1) of a grantable petition to revive under 37 CFR 1.137(b) because the petitioner did not provide the proper reply, *i.e.*, did not submit an executed oath or declaration. Accordingly, the application remains abandoned. The decision was never received -- it was mailed to Dorsey & Whitney LLP, 1330 Connecticut Avenue NW, Suite 200, Washington, DC 20036, which was not the then current (or correct) address of record for Applicants' counsel.

On January 2, 2002, Applicants' counsel spoke with Mr. Jim Lisehora, who provided Applicants' counsel with a copy of the September 18, 2001 decision via facsimile. Attached to the decision was a copy of the Notification of Missing Requirements of July 7, 1999, which indicated that it was sent to an address not corresponding to any address ever of record in the application (hence, providing the reason why Applicants' counsel never received the notification).

Petitioner now submits this Renewed Petition Under 37 CFR 1.137(b) to revive the above-referenced application. Accompanying this renewed petition is an executed declaration and a copy of the Notification of Missing Requirements.

DISCUSSION

In the Decision on Petition mailed September 18, 2001, the Office correctly noted that the proper reply to the Notification of Missing Requirements under 35 U.S.C. § 371 was not provided. In particular, because Applicants had not received the Notification of Missing Requirements, Applicants could not reply, *i.e.*, could not submit the oath or declaration. As Applicants received via facsimile on January 2, 2002 a copy of the Notification of Missing Requirements under 35 U.S.C. § 371, along with the Decision on Petition, Applicants can now submit the proper reply. Accordingly, Applicants submit herewith the declaration, along with a copy of the Notification of Missing Requirements under 35 U.S.C. § 371.

Applicants respectfully submit that the remaining requirement of 37 CFR 1.137(b), as set forth in the Decision on Petition, has now been complied with and all requirements of a grantable petition to revive an abandoned application under 37 CFR 1.137(b) have been met. Based upon the foregoing and the information submitted with the initial Petition to Revive Unintentionally Abandoned Application, granting of this petition is respectfully solicited.

Applicants also respectfully submit that no fee is due for filing this renewed petition requesting reconsideration of the September 18, 2001 decision. Applicants submit that the two-month time period set for filing a request for reconsideration cannot start until the decision is mailed to the appropriate address of record. The decision was never mailed to the appropriate address of record because, as of September 18, 2001 (and for the prior 22 months, *i.e.*, since November 1999), the address of record was Arter & Hadden LLP, 1801 K Street NW, Suite 400K, Washington, DC 20006-31. The decision, however, was mailed to Dorsey & Whitney LLP, 1330 Connecticut Avenue NW, Suite 200, Washington, DC 20036. A copy of the decision

was not sent to Applicants' counsel until January 2, 2002. Applicants respectfully submit, therefore, that the two-month response period began as of that date (*i.e.*, January 2, 2002).

It is further pointed out that, notwithstanding the correspondence address on the inventor declaration, the correct address of record is:

PIPER MARBURY RUDNICK & WOLFE, LLP
1200 Nineteenth Street, N.W.
Washington, D.C. 20036-2412
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Respectfully submitted,
PIPER MARBURY RUDNICK & WOLFE LLP



Jerold I. Schneider
Registration No.: 24,765
Attorney of Record

Laura D. Nammo
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Facsimile : (202) 223-2085



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: ASSISTANT COMMISSIONER FOR PATENTS

Box PCT

Washington, D.C. 20231

07 JUL 1999

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/230275	HICKS	D 5093
JEROLD I SCHNEIDER DORSEY & WHITNEY 1001 CONNECTICUT AVENUE NW SUITE 300 SOUTH WASHINGTON, DC 20004		
INTERNATIONAL APPLICATION NO.		
PCT/US97/13321		
I.A. FILING DATE		PRIORITY DATE
23 JUL 97		24 JUL 96
DATE MAILED		

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as

- ☐ a Designated Office (37 CFR 1.494),
- ☒ an Elected Office (37 CFR 1.495):
- ☒ U.S. Basic National Fee.
- ☒ Copy of the international application in:
 - ☐ a non-English language.
 - ☒ English.
- ☐ Translation of the international application into English.
- ☐ Oath or Declaration of inventor(s) for DO/EO/US.
- ☐ Copy of Article 19 amendments.
- ☐ Translation of Article 19 amendments into English.
- ☒ The International Preliminary Examination Report in English and its Annexes, if any.
- ☐ Translation of Annexes to the International Preliminary Examination Report into English.
- ☐ Preliminary amendment(s) filed _____ and _____.
- ☐ Information Disclosure Statement(s) filed _____ and _____.
- ☐ Assignment document.
- ☒ Power of Attorney and/or Change of Address.
- ☐ Substitute specification filed _____.
- ☐ Verified Statement Claiming Small Entity Status.
- ☐ Priority Document.
- ☒ Copy of the International Search Report ☐ and copies of the references cited therein.
- ☐ Other:

2. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- ☐ a. Translation of the application into English. Note a processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.
 - ☐ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.
- ☐ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).
- ☒ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date.
 - ☐ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
- ☐ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

3. Additional claim fees of \$ _____ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due. See attached PTO-875.**ALL OF THE ITEMS SET FORTH IN 2(a)-2(d) AND 3 ABOVE MUST BE SUBMITTED WITHIN ONE MONTH FROM THE DATE OF THIS NOTICE OR BY ☐ 21 OR ☒ 31 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

4. Translation of the Annexes **MUST** be submitted no later than the time period set above or the annexes will be cancelled. Note processing fee will be required if submitted later than 30 months from the priority date.5. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

A copy of this notice MUST be returned with this response.

Enclosed:

- ☐ PCT/DO/EO/917
- ☐ PTO-875

☐ Notice of Defective Translation

COTTMAN, DARRELL C